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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,044	02/01/2001	Reinhold Stadler	49248	7928

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EXAMINER
LEVY, NEIL S

ART UNIT	PAPER NUMBER
1616	7

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 762044	Applicant(s) STADLER et al
	Examiner [illegible]	Group Art Unit 1616

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 5/28/02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above claim(s) 4-7 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 8-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-10 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Receipt is acknowledged of Response of 5/28/02.

Applicant's election with traverse of polypropyleneoxide, fungi, abrasion generated micropores, polyethylene wax emulsion and the n-methyl acetamide active at page 33, lines 20-23 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there is a technical feature in common—CR granules. This is not found persuasive because the technical features of the species a-e define separate invention; granules with other than elected active are patentably distinct and not required for performance of the elected granule; likewise, the coating elected, is a patentably distinct feature over alternative coating, not required for a given active of a CR granule; these technical features are not seen as shared across all permutations of the claimed invention

The requirement is still deemed proper and is therefore made FINAL.

Claims 4-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-3 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language is ambiguous—we do not know the metes and bounds of the claim. Claim 1 is to a composition; a granule, but, soil-applied implies a method: of applying to the soil, obtainable implies still another method, or a descriptive, optional source of CR granules, with an active in the coating of the granule. We see the claims as to a granule. Please identify (spell out) CR at first occurrence (claim 1) so we are sure we are all in accord with the intended critical ratio granule. "It appropriate" is not definitive, in claim 9, as no criteria are provided as to what additives and concentrations are required under what circumstances, with what ends in mind? It is unclear what steps are required for the claim 1, granule to be allowed to act on plants, seed or the environment. Specific additives (claim 9) should be claimed, as parentheses are not permitted.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. One or ordinary skill in the art of soil application of granules, would not know what pests could be controlled, and what is

meant by control, with allowance of action of any of the unspecified active containing granules of claim 1, allowed to act as per claim 10.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Saur et al –CA 2178655.

The methods and CR granules prepared by coating (page 1) and applied to soil to control fungi (page 4) is not novel. Granule carriers include water-soluble, water insoluble and biodegradable species (page 5, paragraph 2) coated by spraying at the instant temperature (page 5, line 31-36) in fluidized beds, with aqueous wax emulsions (page 5, last paragraph), with additives, inclusive of, e.g., talc, of appropriate (page 7, lines 8-13). Example 1 shows azole application, followed by coating. Example 9 shows azole active, at about 3% in about 27% polymer, with additives, and applied to a

biodegradable carrier by spraying a fluidized bed. No patentable weight is given to the way is which one can obtain the granule of claim 1, we see abrasion as a direct result of the force required in the spraying, of the same coating in the same equipment by the same method as is instantly claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1-3, 8-10 are

Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Saur et al CA—2178655 in view of Rei—4663359 or Arnold, EP 058256.

Saur (above) provides the essence of the instant invention, but does not specifically use the instant claim language and/or explanations.

Rei—shows incorporation of a microbiocide into resin coating (column 3), with abrasion used to provide the instant micropores—of the coating (column 4, line 55-column 6, line 28). Arnold also show advantageous adjuvant use in coatings; here, with polypropyleneoxide (page 3, bottom).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made, desiring to utilize pest compositions, to use one of those known in the art, as exemplified by the primary reference, with selection of the features of interest, as shown exemplary by Rei and Arnold, to provide improved coatings for use as desired.

All the critical elements of the instant are disclosed. The amounts and proportions of each ingredient are result effective parameters chosen to obtain the desired effects. It would be obvious to vary the form of each ingredient to optimize the effect desired, depending upon the particular pest and crop of interest, reduction of toxicity, cost minimization , enhanced, and prolonged, or synergistic effects.

Applicant has not provided any objective evidence of criticality, non-obvious or unexpected results that the administration of the particular ingredients' or concentrations provides any greater or different level of prior art expectation as claimed, and the use of ingredients for the functionality for which they are known to be used is not a basis for patentability.

The instant invention provides well known old art recognized compounds, with well known art recognized effects, applied by well known art recognized methods to achieve control over pests or crops as is well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 305-4556 for regular communications and 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy: mv
July 8, 2002

NEIL S. LEVY
PRIMARY EXAMINER